

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Hilmar WECHSEL)	Group Art Unit: 3689
)	
Application No.: 10/787,205)	Examiner: NGUYEN, Thuy-Vi Thi
)	
Filed: February 27, 2004)	
)	
For: SYSTEMS AND METHODS)	Confirmation No.: 4680
FOR MANAGING PRODUCT)	
RETURNS USING RETURN)	
AUTHORIZATION NUMBERS)	

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellant presents this Reply solely to address issues first raised in the Examiner's Answer dated November 23, 2011.

I. GROUNDS OF REJECTION

In response to the Appeal Brief filed August 30, 2011, the Examiner maintained the rejection of claims 1-6, 9-36, and 40-47 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,536,659 to *Hauser et al.* ("*Hauser*") in view of U.S. Patent Application Publication No. 2002/0178074 to *Bloom* ("*Bloom*").

I. **ARGUMENT**

A. **Overview**

Claims 1-6, 9-36, and 40-47 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Hauser* in view of *Bloom*. Appellant traverses this rejection for the reasons set forth in the Appeal Brief. Here Appellant replies to the additional arguments made by the Examiner in the Examiner's Answer of November 23, 2011.¹

The Examiner's Answer contains six additional arguments against assertions made by Appellant in the Appeal Brief. Each of these additional arguments are unsupported by and/or contradicted by the MPEP and the cited art for at least the following reasons.

B. **Examiner's First Argument**

On page 32 and 33 of the Examiner's Answer, the Examiner argues that the limitation "when the quality of the product associated with the return request" of independent claim 1 and the similar features of independent claims 9, 13, 20, 21, 24, 31, 32, 40, and 41 should be entitled to no weight (Examiner's answer, page 32) because:

[T]he action cover[ed] by the claim encompasses performing the selected conditional to the exclusion of the other alternative. In that regards, the above claim limitation **is an [sic] analogous to optional language**

¹ The Examiner's Answer essentially repeats, with some modifications, arguments made in the Final Office Action mailed April 5, 2011 (see Examiner's Answer, pages 1-32). Applicant traverses these arguments for the reasons provided in the Appeal Brief. New arguments pertaining to the modifications are provided on pages 32-39 of the Examiner's Answer. Applicant addresses these new arguments herein.

according to MPEP 2106.11.C since the conditional language need not occur. (Emphasis added, Examiner's answer, page 32.)

The Examiner has apparently revised the contention made on pages 8 and 32 of the Final Office Action that MPEP 2106.11.C excludes the claimed feature from consideration because it is allegedly "conditional/optional." With this revision, the Examiner apparently correctly concedes, as Appellant argued on pages 22-24 of the Appeal Brief, that MPEP 2106.11.C does not exclude or, in fact, mention "conditional/optional" language. In fact, MPEP 2106.11.C does not mention the word "conditional." By failing to address the argument on pages 24-25 of the Appeal Brief, the Examiner also apparently concedes that there is no explicit basis in MPEP 2106.II.C for concluding that claimed features including the word "when" should be excluded from consideration.

The Examiner's attempt to revise arguments made in the Final Office Action by replacing "conditional/optional" with "analogous to optional" language fails for similar reasons as those argued in the Appeal Brief. Specifically, MPEP 2106.11.C does not mention language that is "analogous to optional language," as the Examiner maintains on page 33 of the Examiner's Answer. Rather, MPEP 2106.11.C, excludes only language that "**suggests or makes optional** but does not require steps to be performed" (emphasis added). The Examiner does not even argue that the above-quoted claim feature "suggest[s]" a step or that it "makes [a step] optional," the only two categories discussed in MPEP 2106.11.C. Therefore, there is no basis in the MPEP for the Examiner's categorization of the claim language as "analogous to optional

language,” nor does MPEP 2106.11.C provide any basis for excluding such language from consideration.

Moreover, the Examiner’s argument that “conditional” language is analogous to the “optional language” of MPEP 2106.11.C is logically flawed at least because the “conditional” language does not include even a single option or suggestion. The Examiner argues that, because “Appellant method claim does not require all the branches of conditional to perform nor repeating the method step until all the branches are performed” the above-quoted feature is “analogous to optional language.” This argument rests on the assumption that any “branch” that is not required to be performed at all times is optional (i.e., “analogous to optional language”). Yet, not “require[ing] all branches of [a] conditional” phrase to be performed at all times is not the equivalent to providing an option or suggestion, as discussed in MPEP 2106.11.C. Rather, it simply means that some branches must be performed under certain conditions while other branches must be performed under different conditions. The Examiner impliedly admits as much at least on page 32 of the Final Office Action by characterizing “[the claim] recited the condition when the quantity of the product in the second record does not match the quantity of the product received, and then the splitting record will occur” (emphasis added). Therefore, the claim language cannot be considered as analogous to “optional language” because it provides no options or suggestions, only requirements that must be performed under certain conditions.

Because the Examiner’s rejection relies upon an incorrect reading of MPEP 2106.11.C, the rejection under 35 U.S.C. 103(a) should be withdrawn.

C. Examiner's Second Argument

On pages 34-36 of the Examiner's Answer, the Examiner argues:

BLOOM is used to show the fair teaching of [sic] splitting record 1202 or creating the new record 1202 when the physical quantity of the items are [sic] received are less than the quantity of the items stored in the record so that the new record would match with the actual physical quantity. (Emphasis added, Examiner's Answer page 36.)

However, this is incorrect. The cited portions of *Bloom* (i.e., paragraphs [0099], [0187]) do not disclose splitting records "when the physical quantity of the items are [sic] received are less than the quantity of the items stored in the record" (emphasis added). Rather, to the extent that *Bloom* discloses splitting records in paragraphs [0099] and [0187], the splitting of records is for correcting packing errors of packages to be sent. Therefore, even if the Examiner were to rely on *Bloom* for the general teaching of splitting records, as the Examiner seems to imply on page 36 of the Examiner's Answer ("BLOOM is used to show the fair teaching of [sic] splitting record 1202 [...]", *Bloom* would still fail to disclose at least splitting the records "when the quantity of the product associated with the return request included in the second record does not match the quantity of the product received at the warehouse," as claimed in independent claim 1 and the similar features in independent claims 9, 13, 20, 21, 24, 31, 32, 40, and 41.

For example, in paragraph [0187], *Bloom* discloses steps to correct a "packing error" in a delivery when a "package was under-packed (meaning a lesser quantity [than scheduled for delivery] was physically placed in the package)." Similarly, *Bloom* discloses "partially fill[ing an order for a delivery] by creating a new Order Detail record 1202 and splitting the Order Detail Quantity" in paragraph [0099]. As *Bloom* discloses in paragraph [0099], the splitting occurs "where a selected Order Detail record 1202

[calls for a] quantity greater than can be filled by the cases which have been included in the retailer shipment,” not “when the physical quantity of the items are [sic] received are less than the quantity of the items stored in the record” (emphasis added), as the Examiner maintains.

Therefore, *Bloom* discloses splitting records where there is a shortfall of inventory stored for delivery, not according to any “quantity of the product received at the warehouse” (emphasis added), as claimed. Because of this, *Bloom* fails to make up for the deficiencies of *Hauser* at least with respect to the claimed features of claim 1 and the similar features in independent claims 9, 13, 20, 21, 24, 31, 32, 40, and 41.

D. Examiner’s Fourth Argument

In response to Appellant’s argument on pages 28-31 of the Appeal Brief², the Examiner argues that, even though the cited art does not disclose recombining records, such would be obvious because:

Since the split [disclosed by *Bloom*] was only formed because of the problem, one of ordinary skill and creativity in the art would have readily recognized no more need for split and would not need to maintain the overhead of duplicate records. (Examiner’s Answer, page 37.)

The Examiner’s Answer provides a new motivation for the addition of this feature to *Hauser* and *Bloom* not present in the Final Office Action, namely that recombining would be performed “as a matter of common sense of indicating the problem has been solved as well as saving the space in the data storage” (Examiner’s Answer, page 37).

² That the Examiner admits that the combination of *Hauser* and *Bloom* fails to disclose at least “recombining the records into a single record when the quantity of the product matches the quantity of the received product,” as claimed in independent claims 1, 9, 13, 20, 21, 24, 31, 32, 40, and 41, and provides only a conclusory statement that this feature is “obvious.”

The Examiner's inclusion of a new motivation in the Examiner's answer seems to be an implicit concession that the motivation provided in the Final Office Action was derived from Appellant's own specification.³

Even with the new motivation, however, the rejection still does not meet the requirements set forth in MPEP 2141.III. The Examiner provides nothing more than a conclusory statement that recombination of the records "would have readily [been] recognized" "as a matter of common sense." The Examiner admits that the claimed feature is not present in any of the cited art,⁴ does not suggest that the claimed feature is known in the art, and does not take Official Notice of the claimed feature. Therefore, the Examiner is merely asserting that the feature is "common knowledge" in the art without providing any evidentiary support, which is an unacceptable grounds of rejection.^{5,6}

Therefore, the Examiner provides no basis for this claimed feature other than to assert that it "would have readily recognized" "as a matter of common sense" (i.e., that it is "obvious"). For at least this reason, the rejection under 35 U.S.C. 103(a) should be withdrawn.

³ See page 30 of the Appeal Brief in which Appellant explains that the motivation to combine is apparently derived from Appellant's own specification and, therefore, represents impermissible hindsight reasoning under MPEP 2145.X.A.

⁴ "HAUSER/BLOOM does not mention about the recombining the records into the single record when the quantity of the product in the record matches the quantity of the received product" (Examiner's Answer, page 12).

⁵ "It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. MPEP 2144.03.A. (Emphasis added.)

⁶ "[A]ssertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art." *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. MPEP 2144.03.A. (Emphasis added.)

D. Examiner's Fifth Argument

In response to Appellant's argument on pages 31-33 of the Appeal Brief⁷, the Examiner argues that:

Examiner respectfully disagrees with this argument due to the reason the Examiner addressed in section (2) above.
(Examiner's Answer, pages 37-38).

However, the Examiner has simply failed to address Appellant's arguments on pages 31-33 of the Appeal Brief. More specifically, the Examiner fails to address the fact that, although Examiner proposes to recombine records of *Bloom* "when the quantity of received product matches with the original quantity of product stored in the record in order to indicate that the problem has been solved," this condition never occurs in *Bloom*.⁸ The Examiner also fails to address Appellant's argument that recombining records of *Bloom* after the packages have been sent for delivery, even if it were possible, is contrary to the explicit teachings of *Bloom* at least in paragraphs [0187] and [0099].⁹

Therefore, the Examiner fails to address and, therefore, apparently concedes Appellant's arguments that Examiner's combination of *Hauser* and *Bloom* fails to teach or suggest the claimed feature of recombining the records, and that such changes

⁷ That the Examiner's proposed addition of record recombination to *Bloom* would at least change the principle of operation of *Bloom* and render *Bloom* unsatisfactory for its intended purpose.

⁸ See Appellant's Argument, Appeal Brief page 32.

⁹ See Appellant's Argument, Appeal Brief pages 32-33.

would at least change the principle of operation of *Bloom* and render *Bloom* unsatisfactory for its intended purpose. For at least these reasons, the rejection under 35 U.S.C. 103(a) should be withdrawn.

E. Examiner's Sixth Argument

In response to Appellant's argument on pages 33-34 of the Appeal Brief¹⁰, the Examiner argues that:

While the claim recites that second computer implement management system is the system of a supplier, **the Examiner asserts that the ownership of the system doesn't appear to make a manipulative differen[ce] in a method step of "creating a record" as indicated in the method, and "the supplier" as recited in the system claims 32 and 34** is merely the ownership name of the database which also does not change the structure of the computer as well as the function of "create the record"..(Examiner's answer, page 38, emphasis added.)

However, the Examiner has simply failed to address Appellant's arguments on pages 33-35 of the Appeal Brief, apart from broadening the "manipulative differen[ce]" argument to explicitly include the claims to a system.¹¹ Therefore, the Examiner's Answer still appears not to consider the claim words claimed features "of a supplier" in the obviousness analysis of these claims. Omitting claim words from obviousness analysis is impermissible for any reason under at least MPEP 2143.03, as quoted above. Moreover, the Examiner's apparent reasoning for failing to consider these claimed features finds no basis in the MPEP or case law.

¹⁰ That the Examiner fails to consider at least the claimed limitation "creating at least one record in each of a plurality of second computer-implemented management systems of a supplier" in independent claims 9, 13, 20, 21, 24, 31, 32, and 41.

¹¹ Thereby apparently addressing Appellant's argument on page 35 of the Appeal Brief that "'Appear[ing not] to make a manipulative differen[ce] in a method' (emphasis added) certainly cannot be a reasonable basis for disregarding features of claims to a system."


For at least these reasons, the rejection under 35 U.S.C. 103(a) with respect to claims 9, 13, 20, 24, 31, 32, and 41 should be withdrawn.

II. CONCLUSION

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: January 18, 2012

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